



BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE
ON APPEAL TO THE BOARD OF APPEALS

White Application of: Kenneth P. Singleton) Date: December 14, 2001
Serial No. 09/756,588) Group Art Unit: 3765
Filed: 07/14/97) Examiner: L. Worrell, Jr.
Title: Dual Sleeved Sock And Method of)
Manufacturing The Same)

T-3765 MAIL ROOM

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CERTIFICATE OF SERVICE

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Terry LAKOS
Name: Terry LAKOS

12/21/01
Date

BRIEF ON APPEAL UNDER 37 C.F.R. 1.192

Hon. Commissioner of Patents and Trademarks
Washington, D.C. 20231

Dear Sir:

This is an appeal from the Final Rejection, dated August 27, 2001 for the above identified application.

REAL PARTY IN INTEREST

The party(ies) named in the caption of this brief are the real parties of interest in this appeal.

RELATED APPEALS AND INTERFERENCES

12/31/2001 CV0111 00000028 09756588

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There are no other appeals or interferences known to appellant, appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in this pending appeal.

STATUS OF CLAIMS

Claims 1-8 remain pending and appealed in the present applications.

STATUS OF AMENDMENTS

There have been no supplemental amendments filed after final rejection.

SUMMARY OF INVENTION

Referring to the specification, page 6 line 16 through page 8, line 8 and FIGS. 1-3, a dual sleeved sock 10 is shown comprised of an inner cuff 15 and a foldable outer cuff 40. The dual sleeved sock 10 is knitted of a cotton material in any of many knit stitch constructions known to one skilled in the hosiery art. The inner cuff 15 is defined as having an inner portion 16 of which remains next to a user's skin when worn by the user, and an opposing outer portion 17. The inner and outer portions 16, 17 comprise a foot-covering portion 20 which includes a toe portion 22 and a heel portion 24. The inner and outer portions 16, 17 further comprise a leg-covering portion 30 which includes the foldable, outer cuff 40 formed integrally therewith along a linearly elongated centerline thereof. It is envisioned that the cuff 40 may be fabricated as a separate loop which could be sewn on at a later time. The cuff 40 is designed and

configured so as to fold downward in a direction away from the leg-covering portion 30 to the heel portion 24, in such a manner whereby the cuff 40 folds over a top portion of a boot 25 so as to effectively cover upper boot laces. The cuff 40 includes a selvage makeup 42 formed preferably of several rounds of elastic yarn 43, and a group of courses of suitable knit stitch link patterns positioned adjacent for fabricating the cuff 40. The resulting functionality of the cuff 40 serves to prevent the entry of dirt, rocks, ticks, insects, and other small objects from entering the user's boots 25. The cuff 40 also serves as a covering shield for preventing boot laces 26 from becoming untied. Exposed boot laces 26 are more susceptible to being snagged by twigs or other objects causing the laces to become untied, thus creating a tripping hazard. The cuff 40 further serves to prevent the sock 10 from sliding down the user's leg and into the boot 25 through the course of the day. Typically, friction and motion of a leg and ankle when walking cause the boot 25 to pull the sock 10 down. Being folded over the top portion of the boot, the cuff 40 is frictionally held thereto via the selvage makeup 42, thus the cuff 40 aids in making the sock 10 less apt to sliding down the user's leg and into the boot.

ISSUES

The present issues on appeal are:

1. Are claims 1-4 fully anticipated under 35 U.S.C. 102 (b) in view of Meengs et al (2,578,895)? and
2. Are claims 5-8 anticipated under 35 U.S.C. 103(a) as being anticipated by Meengs et al (2,578,895) in view of Kerns. (4,513,589)?



GROUPING OF CLAIMS

Claim 1-4 forms a first group of claims that can stand or fall together; and, Claims 5-8 forms a second group of claims that stand or fall together in this appeal.

ARGUMENT

1. Rejections under 35 U.S.C. 102

Claims 1-4 were rejected under 35 U.S.C. 102.

In undertaking to determine whether one reference anticipates another under 35 U.S.C. 102(b), a primary tenet is that the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Many differences exist between the invention claimed in Meengs et al. and the currently claimed invention. To briefly summarize the distinguishing features and characteristics between the two, Meengs et al. teaches a combined hose and shoe guard.. Also, the examiner notes that the inner cuff of Meengs et al. is fabricated as separate loop from the outer cuff.

In contrast, as claimed in Claim 3 of the present invention, the leg-covering portion includes a foldable, outer cuff formed *integrally* with said leg-covering portion.

In addition, Meengs et al. fails to teach a selvage makeup formed of several rounds of elastic yarn which serves not only as a covering shield for boot laces, but also serves to prevent the sock from sliding down the user's leg and into the boot through the course of the day.

Therefore, because of the aforementioned differences between Meengs et al. and the present invention, the examiner's rejection of Claims 1-4 under 35 U.S.C. 102(b) is inappropriate.

2. Rejections under 35 U.S.C. 103

Applicant wishes to point out again the arguments of the prior amendments that it is well established at law that for a proper *prima facie* rejection of a claimed invention based upon obviousness under 35 U.S.C. 103, the cited references must teach every element of the claimed invention. Further, if a combination is cited in support of a rejection, there must be some affirmative teaching in the prior art to make the proposed combination. See Orthopedic Equipment Company, Inc. et al. v. United States, 217 USPQ 193, 199 (Fed. Cir. 1983), wherein the Federal Circuit decreed, "Monday Morning Quarter Backing is quite improper when resolving the question of obviousness." Also, when determining the scope of teaching of a prior art reference, the Federal Circuit has declared:

"[t]he mere fact that the prior art could be so modified should not have made the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis added). In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

There is no suggestion as to the desirability of any modification of the references

to describe the present invention. An analysis of the disclosures within the cited references fails to cite every element of the claimed invention. When the prior art references require a selective combination to render obvious a subsequent claimed invention, there must be some reason for the selected combination other than the hindsight obtained from the claimed invention itself. Interconnect Planning Corp v. Feil, 774 F.2d 1132, 227 USPQ 543 (CAFC 1985). There is nothing in the prior art or the examiners arguments that would suggest the desirability or obviousness of the combination of features and elements claimed in the dual sleeved sock and method of manufacturing the same. Uniroyal, Inc. v. Rudkki-Wiley Corp., 837 F.2d 1044, 5 USPQ 2d 1432 (CAFC 1988). The examiner seems to suggest that it would be obvious for one of ordinary skill to attempt to produce the currently disclosed invention. However, there must be a reason or suggestion in the art for selecting the design, other than the knowledge learned from the present disclosure. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ.2d 1529 (CAFC 1988); see also In re O'Farrell, 853 F.2d 894, 7 USPQ 2d 1673 (CAFC 1988).

Further, in rejecting claims under 35 U.S.C. 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. 1993) A prima facie case of obviousness is established by presenting **evidence** that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Although many sources of suggestion are allowed, this requirement for actual evidence must be met

with a clear and particular showing. See, e.g. C.R. Bard Inc. v. M3 Sys., Inc. 1527 F.3d 1340, 1352, 48 USPQ2d 1255, 1232 (Fed. Circ. 1998). A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not "evidence." See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ 1614, 1617 (Fed. Cir. 1999).

Therefore, the examiner's rejection of claims 4-8 under 35 U.S.C. 103(a) on obviousness grounds was improper. Most importantly there is no suggestion in any of the references for the combination proposed. If a combination is cited in support of a rejection, there must be some affirmative teaching in the prior art to make the proposed combination. Orthopedic Equipment, supra.

Accordingly, the reversal of the Examiner by the honorable Board of Appeals is respectfully solicited.

Respectfully submitted,

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APPENDIX

THE CLAIMS ON APPEAL

The claims on appeal are as follows:

I Claim:

1. A sock comprising:
an inner cuff; and
foldable outer cuff.
2. The sock of Claim 1, wherein said inner cuff is defined as having an inner portion of which remains next to a user's skin when worn by the user, and an opposing outer portion, said inner and outer portions comprise a foot-covering portion which includes a toe portion and a heel portion.
3. The sock of Claim 2, wherein said inner and outer portions further comprise a leg-covering portion which includes said foldable, outer cuff formed integrally therewith along a linearly elongated centerline thereof, wherein said outer cuff is designed and configured so as to fold downward in a direction away from the leg-covering portion to the heel portion in such a manner whereby the cuff folds over a top portion of a boot so as to effectively cover upper boot laces.
4. The sock of claim 1, wherein said inner cuff is fabricated as a separate loop from said outer cuff.

5. The sock of Claim 3, wherein said outer cuff includes a selvage makeup formed of several rounds of elastic yarn, and a group of courses of suitable knit stitch link patterns positioned adjacent for fabricating said outer cuff.
6. A sock of Claim 5, wherein said selvage makeup is formed by interlacing the rounds of yarn in alternate needles for forming an initial knit stitch link pattern.
7. The sock of Claim 6, wherein a single round of yarn is subsequently knitted on all needles so as to form a desired remaining group of courses of suitable knit stitch link patterns making up the cuff.
8. The sock of Claim 7, wherein upon completion of the knitting of a final course of the inner portion, the leg-covering portion and the foot-covering portion are knitted by feeding yarn to all needles so that the identical suitable knit stitch link pattern are formed, thereby automatically integrally knitting the cuff to the linearly elongated centerline of the leg-covering portion.